P21470.P11

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Mail Stop AF AF/1731

Response under 37 C.F.R. 1.116
Expedited Procedure Requested
Examining Group. 1731

Corres. and Mail
BOX AF

Attorney Docket No. P21470

In re application of : Markus OECHSLE et al.

Serial No. : 09/936,516

Filed : December 5, 2001

Group Art Unit : 1731

Examiner : M. Halpern

For : DEVICE FOR DETERMINING THE CHARACTERISTICS OF A RUNNING MATERIAL

Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is a Response under 37 C.F.R. 1.116 in the above-captioned application.

___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
___ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
___ A Request for Extension of Time.
X A Supplemental Information Disclosure Statement, form PTO-1449, and references cited..
X No Additional Fee.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 71	*72	0	x 9=	$	x 18=	$0.00
Indep. Claims: 3	**3	0	x 42=	$	x 84=	$0.00.
Multiple Dependent Claims Presented			+140=	$	+280=	$0.00
Extension Fees for Month				$		$0.00
			Total:	$	Total:	$0.00

*If less than 20, write 20
**If less than 3, write 3
___ Please charge my Deposit Account No. 19-0089 in the amount of $____.
N/A A Check in the amount of $_____ to cover the filing/extension fee is included.
X The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
X Any additional filing fees required under 37 C.F.R. 1.16.
X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of times fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3)

#45,294

Neil F. Greenblum
Reg. No. 28,394

P21470.A07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Markus OECHSLE et al.

Art Unit: 1731

Appln. No. : 09/936,516

Filed : December 5, 2001

Examiner: M. Halpern

For : DEVICE FOR DETERMINING THE CHARACTERISTICS OF A RUNNING MATERIAL

RESPONSE UNDER 37 C.F.R. 1.116

Commissioner For Patents
PO Box 1450,
Alexandria, Virginia 23313-1450
Sir:

Responsive to the Final Official Action of June 2, 2003, reconsideration and withdrawal of the rejections made therein are respectfully requested, in view of the following amendments and remarks.

Inasmuch as the Official Action sets a three-month shortened statutory period which expires September 2, 2003, this Amendment is being timely filed, i.e., within two months of the Final Rejection, and no extension of time is believed necessary. However, if an extension is deemed by the Patent and Trademark Office to be necessary, the same is hereby requested and the Patent and Trademark Office is hereby authorized to charge any necessary fees in connection therewith or any fees necessary to preserve the pendency of this application to deposit account No. 19-0089.

REMARKS

Summary of the Response

Claims 33-46 and 48-104 are currently pending, with claims 33, 99 and 100 being in independent form.

Summary of the Official Action

In the instant Office Action, the Examiner provisionally rejected claims 33, 99 and 100 on the basis of obviousness-type double patenting over copending application No. 09/936,526. By the present remarks, Applicant respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

The Finality of the Instant Office Action is Improper

In the instant Final Office Action, the Examiner indicated in the Office Action Summary that all pending claims 33-46 and 48-104 were rejected. However, the Examiner only treated claims 33, 99 and 100 on the merits and failed to specifically indicate the status (i.e., rejected or allowed) of claims 34-46, 48-98 and 101-104.

In particular, the Examiner only provisionally rejected claims 33, 99 and 100 on the basis of obviousness-type double patenting over copending application No. 09/936,526. On the other hand, claims 34-46, 48-98 and 101-104 were not treated on the merits.

Accordingly, Applicant respectfully submits that the finality of the instant Office Action is improper and should be withdrawn, and further requests that the Examiner indicate the status of all pending claims in the next Office Action.

Traversal of Double Patenting Rejection

Applicant respectfully requests reconsideration of the provisional obviousness-type double patenting rejection of claims 33, 99 and 100.

Contrary to the Examiner's assertions, Applicant submits that the instant claims 33, 99 and 100 recite features which are not disclosed or suggested by claims 77, 87 and 31 of US patent application 09/936,526.

Applicant notes that claim 77 of the '526 application recites, inter alia, a system comprising *a plurality of measurement zones arranged in series along a process direction of the machine*, at least one of the plurality of measurement zones being located in the at least one machine section, *at least one measurement device for detecting data being located in each of the plurality of measurement zones*, *each of the measurement devices detecting the data while moving along at least two degrees of freedom of movement*, and *an evaluation unit for evaluating the data*. On the other hand, claim 33 of the instant application recites, inter alia, an apparatus comprising at least one measuring device, the at least one measuring device being movable and having at least two degrees of freedom of movement, *each of the at least*

two degrees of freedom of movement being at least one of a rotary movement and a linear movement, the at least one measuring device being adapted to detect, at a plurality of measurement locations, data relating to at least one measured parameter, and *the at least one measuring device detecting data about at least one of the following measured parameters: measured parameters which relate to a characteristic value of air in a region of the material web; measured parameters which relate to the material web; and other measured parameters*, wherein the at least one measuring device moves along the at least two degrees of freedom of movement during data detection. Clearly, each of these claims recite one or more features which are not recited in the other. For example, claim 77 of the '526 application recites *a plurality of measurement zones arranged in series along a process direction of the machine.* Claim 77 also recites *at least one measurement device for detecting data being located in each of the plurality of measurement zones.* On the other hand, neither of these features is recited in claim 33 of the instant application. Nor have these features been shown to be obvious. Indeed, the Examiner has identified no prior art suggesting that these features are obvious.

Applicant additionally notes that claim 87 of the '526 application recites, inter alia, a system comprising *a plurality of measurement zones arranged in series along a process direction of the machine, each of the dryer section and the refinement section including at least two measurement zones*, at least one measurement device for detecting data being

located in a region of each measurement zone, each of the measurement devices detecting the data while moving along at least two degrees of freedom of movement, and *an evaluation unit for evaluating the data being coupled to each of the measurement devices*, wherein the data concerns at least one measured parameter relating to the manufacture or refinement of the material web. On the other hand, claim 99 of the instant application recites, inter alia, an apparatus comprising *at least one measuring device*, the at least one measuring device being movable and having at least two degrees of freedom of movement, *at least one of the at least two degrees of freedom of movement being a rotary movement, at least another of the at least two degrees of freedom of movement being a linear movement*, the at least one measuring device being adapted to detect, at a plurality of measurement locations, data relating to at least one measured parameter, and *the at least one measuring device detecting data about at least one of a parameter relating to a characteristic value of air in a region of the material web and a parameter which relates to the material web*, wherein the at least one measuring device moves along the at least two degrees of freedom of movement during data detection. Clearly, each of these claims recite one or more features which are not recited in the other. For example, claim 87 of the '526 application recites *a plurality of measurement zones arranged in series along a process direction of the machine*, and *each of the dryer section and the refinement section including at least two measurement zones*. Claim 87 also recites *an evaluation unit for evaluating the data being coupled to each of the measurement*

devices. On the other hand, neither of these features is recited in claim 99 of the instant application. Nor have these features been shown to be obvious. Indeed, the Examiner has identified no prior art suggesting that these features are obvious.

Applicant also notes that claim 31 of the '526 application recites, inter alia, a method of operating a machine for manufacturing and/or refining a material web wherein the machine includes at least one machine section, the method comprising *arranging a plurality of measurement zones in series along a process direction*, and *detecting data in each of the plurality of measurement zones using at least one measurement device that detects the data while moving along at least two degrees of freedom of movement*, wherein the data concerns at least one measured parameter relating to the manufacture or refinement of the material web. On the other hand, claim 100 of the instant application recites, inter alia, a method for determining characteristics of a running material web using an apparatus for determining characteristics of a running material web which includes at least one measuring device, the at least one measuring device being movable and having at least two degrees of freedom of movement, each of the at least two degrees of freedom of movement being at least one of a rotary movement and a linear movement, the method comprising moving the at least one measuring device along the at least two degrees of freedom of movement, and *during the moving, detecting data relating to at least one measured parameter, at a plurality of measurement locations and using the at least one measuring device*, wherein *the at least one*

measuring device is adapted to detect data about at least one of the following measured parameters: measured parameters which relate to a characteristic value of air in a region of the material web; measured parameters which relate to the material web; and other measured parameters. Clearly, each of these claims recite one or more features which are not recited in the other. For example, claim 31 of the '526 application recites *arranging a plurality of measurement zones in series along a process direction.* Claim 31 also recites *detecting data in each of the plurality of measurement zones using at least one measurement device that detects the data while moving along at least two degrees of freedom of movement.* On the other hand, neither of these features is recited in claim 100 of the instant application. Nor have these features been shown to be obvious. Indeed, the Examiner has identified no prior art suggesting that these features are obvious.

Accordingly, it is clear that the two applications claim different and distinct subject matter. It is also clear that the Examiner has failed to make a prima facie case of obviousness. Indeed, the Examiner has set forth no prior art and/or motivation in support of the assertion that the claims of both applications are not patentably distinct from each other. Finally, the Examiner has identified no basis for disregarding distinct features which are clearly recited in each of these claims.

Applicant reminds the Examiner of the guidelines identified in MPEP 804 which explains that a double patenting rejection of the obviousness-type is "analogous to [a failure

to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Thus, Applicant respectfully disagrees with the assertion and conclusion of obviousness on the basis that the claims of both applications recite a combination of features which are not rendered obvious over one another.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the Obviousness-type Double Patenting rejection.

The Provisional Rejection of at least one of the Applications Should be Withdrawn

Applicant notes that the instant application and copending application No. 09/936,526 were both provisionally rejected on the basis of obviousness-type double patenting. Moreover, these rejections are the only rejections remaining in both applications.

Applicant reminds the Examiner of the guidelines of MPEP 822 which explains that if the "provisional" double patenting rejections in both application are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent. The examiner should

maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Accordingly, at the very least and notwithstanding the fact that the provisional obviousness-type double patenting rejections are improper as to each application for the reasons indicated herein, Applicant requests that the Examiner withdraw the provisional rejection of at least one of these applications on the basis of MPEP 822.

Comments on Reasons for Allowance

In response to the Statement of Reasons for Allowance set forth in the Office Action, Applicant wishes to clarify the record with respect to the basis for the patentability of the indicated claims in the present application. In this regard, while Applicant does not disagree with the Examiner's indication that certain identified features are not disclosed by the references, Applicant submits that the claims in the present application recite a combination of features, and that the basis for patentability of these claims is based on the totality of the recited features.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicant's invention, as recited in each of the pending claims.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Respectfully submitted,
Markus OECHSLE et al.

Reg. No. 45,294

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July 21, 2003
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